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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,155	12/10/2001	Gerd M. Muller	740105-81	7221

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EXAMINER

DABNEY, PHYLESHA LARVINIA

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/010,155

Applicant(s)

MULLER ET AL.

Examiner

Phylesha L Dabney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 12-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This action is in reference to the request for reconsideration filed 22 September 2004 in which claims 1-11 are pending.

#### *Election/Restrictions*

1. Applicant's election without traverse of Species I in Paper No. 4 is acknowledged. Upon allowability of claim 1, Species II-III and VI-VIII are subject to possible rejoinder to the application.
2. Claims 26-33 and 47-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species IV-V and IX-XII, there being no allowable generic or linking claim. Election was made **with** traverse in Paper No. 4.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6 and 9-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,999,632.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims in the present application are covered by the scope of the claims in the patent with obvious wording variations; for example, Leysieffer et al (U.S. Patent No. 5,999,632) teaches a fixation element comprising a cylindrical housing part, surrounding a housing part of a microphone, including projecting elastic flange parts which is engageable against a side wall of the wall of the auditory canal which reads on the limitations presented in claims 1 of application (Application No. 10/010155) which teaches a fixation element comprising a cylindrical portion, surrounding a housing part of a microphone, including at least one elastic region of increased diameter adapted for insertion into a bore which crosses a wall of the auditory canal of a user, in addition to other examples comparable examples between the application and patent.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Leysieffer et al (U.S. Patent No. 5,999,632).

Regarding claim 1, Leysieffer teaches a fixation element (20) for an implantable microphone, wherein the fixation element comprises an essentially cylindrical portion (14) adapted to be inserted into a bore (fig. 1) which crosses a wall of the auditory canal of a user,

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said cylindrical portion, at least in an implanted state of the fixation element, surrounding an outer circumferential portion of a housing part of the microphone (11), which housing part is provided with a sound receiving member (13), wherein said cylindrical portion includes at least one elastic region (21-25) of increased diameter, said elastic region contacting, in the implanted state of the fixation element, a wall of said bore and providing, by elastic restoring forces, for a friction which is sufficiently high to fix said cylindrical portion in at least one of the two axial directions of said bore (fig. 1).

Regarding claim 2, Leysieffer teaches the region of increased diameter is defined by at least one sealing member (21-25), which is adapted to sealingly contact the wall of the bore upon said cylindrical portion having been inserted into the bore.

Regarding claim 3, Leysieffer teaches the fixation element comprising at least two of such sealing members (21-25), which are axially spaced from each other.

Regarding claim 4, Leysieffer teaches the restoring forces of the at least one sealing member (21-25) are sufficient to prevent movement of the fixation element towards the side of the wall of the auditory canal remote from the skin of the auditory canal (fig. 1).

Regarding claim 5, Leysieffer teaches the outer circumference of the at least one sealing member (21-25), when disposed outside of said bore, is larger than the inner circumference of said bore (fig. 1).

Regarding claim 6, Leysieffer teaches the at least one sealing member is a sealing lip (21-25).

Regarding claim 9, Leysieffer teaches the fixation element, wherein a first one of said sealing members (21-25) is disposed at the end of the cylindrical portion (near 13), which, in the implanted state, faces the skin of the auditory canal.

Regarding claim 10, Leysieffer teaches the fixation element comprising a pair of sealing members (21-25) wherein a second one of said sealing members (22, 25; also col. 2 lines 33-43) is axially spaced from said first sealing member (22, 25; also col. 2 lines 33-43) so as to contact, in the implanted state, the wall of the bore (fig. 1) near the end of the bore remote from the skin of the auditory canal.

Regarding claim 11, Leysieffer teaches the cylindrical portion is connected to a flange portion (23-25) of increased diameter, said flange portion, in the implanted state, contacting the side of the wall of the auditory canal remote from the skin of the auditory canal.

#### *Allowable Subject Matter*

5. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

6. Applicant's election with traverse of Species I in the reply filed on 7 June 2004 is acknowledged. The traversal is on the ground(s) that mutual exclusivity [MPEP806.04(f)] was not considered. This is not found persuasive because although it is true that species VI-VIII are

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not obvious over species I-III, they are subject to a rejoinder which is explained above. The requirement is still deemed proper and is therefore made FINAL.

7. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

With respect to the application argument pertaining to the sealing lips presented in claims 7-8, those claims are objected to as being dependent upon a rejected base claim.

With respect to the applicant's argument pertaining to the elastic flange 23 not engaging the bore of the auditory wall. The rejection has been amended to included items 21-25, specifically items 22, 25 (see claim 10) have been replaced as the appropriate sealing members.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phylesha L Dabney whose telephone number is 703-306-5415. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, Fridays 8:30-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 3, 2005

PLD

  
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